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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,696	05/29/2001	Glenn G. Strawder		5731

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William D. Hall
10850 Stanmore Drive
Potomac, MD 20854-1522

EXAMINER

PORTER, RACHEL L

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,696

Applicant(s)

STRAWDER, GLENN G.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/29/01 & 10/9/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 5/29/01. Claims 1-18 are pending.

Information Disclosure Statement

2. The information disclosure statement filed 5/29/01 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

In particular, the Examiner has considered the **patents** listed on the 1449 forms filed 5/29/01 and 10/09/01. However, while applicant is not required to resubmit the documents provided in a previous IDS from a parent application, Applicant must provide a listing of all documents (e.g. the NPL from the 10/9/01 IDS) in the proper IDS format as outlined above if Applicant would like those documents to be considered by the Examiner in the current application.

Specification

3. The disclosure is objected to because of the following informalities:

See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2,4,7,8,10,13,14 and 16 recite the limitation "and/or." The inclusion of this phrase renders these claims vague and indefinite because it is unclear to the Examiner which components or functions are required as a part of the claimed invention. For the purpose of applying art, the Examiner will only consider that one of options listed in the "and/or" option is required. (i.e. The examiner will consider the recitation of "and/or" as a recitation of "or".)

Claims 2-6, 8-12 and 14-18 inherit the deficiencies of their respective independent claims and are therefore also rejected.

As per claim 7, it is unclear to the Examiner which statutory class of invention Applicant intends to claim. While the preamble recites an apparatus, dependent claims

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8-12 each recite a method with an additional step/function. Moreover, it is unclear whether the "means for controlling said one or more computers..." is software/computer executable instructions or if applicant intends to claim the functions performed by an individual. Furthermore, claim 7 recites "said first computer" in line 14 of the claim. The current claim language only requires one computer (i.e. one or more). However, the recitation of "said first computer" suggests that multiple computers are required to address the claim limitations. For the purpose of applying art, the Examiner while interpret the claim to mean that only one computer is required to address the claim limitations. Claims 8-12 inherit the deficiencies of claim 7 through dependency, and are therefore also rejected.

As per claims 14-18, it is unclear to the Examiner which statutory class of invention Applicant intends to claim. While claims 14-18 are dependent from claim 13, the preamble of claim 13 recites an apparatus, the dependent claims 14-18 each recite a method with an additional step.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-2,5-8,11-14, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorne (USPN 6,282,513).

[claim 1] Dorne teaches a method of monitoring the operations of a machine that takes pictures of the internal anatomy of a body said method comprising:

- providing one or more computers having at least one memory, (Figure 1, ref. no. 100.)
- controlling said one or more computers to perform the following operations:
 - o storing in said memory a standard procedure for said machine or for said operator, or for said examination, applicable to the taking of a picture for at least one medical reason (col. 6, lines 9-17, Fig. 3C)
 - o entering in a memory of said one or more computers a procedure for said machine, or for said operator, or for said examination, relative to the actual taking of a picture of a body part of a patient, (col. 6, lines 38-40; col. 11, lines 30-33)
 - o performing in said one or more computers the step of analyzing the data from said one or more computers, (col. 6, line 67-col. 7, line 24—e.g. generate cpt codes)
 - o providing a computer output from said one or more computers disclosing the results of any analysis performed on said data. (col. 7, lines 11-24-e.g. view codes)

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[claim 2] Dorne discloses a method as defined in claim 1, comprising determining whether any part of the monetary price, involved in the preparation of or the actual taking of the picture, should be, or should not be, added to the cost of the examination. (col. 9, lines 13-36, lines 53-60—determines if images should be approved and processed for billing reports to be generated)

[claims 5-6] Dorne disclose a method as defined in claim 1, comprising: determining how many of a particular examination have been performed and determining how much money a particular number of examinations produce. (col. 15, lines 60-col. 16, line 19)

[claim 7] Dorne discloses an apparatus for monitoring the operations of a machine that takes pictures of the internal anatomy of a body, said machine comprising:

- one or more computers having at least one memory, (Figure 1, ref. no. 100.)
- means for controlling, said one or more computers to perform the following operations (col. 4, lines 24-52):
 - o storing in said memory a standard procedure for said machine or for said operator, or for said examination, applicable to the taking of a picture for at least one medical reason (col. 6, lines 9-17, Fig. 3C)
 - o entering in a memory of said one or more computers a procedure for said machine, or for said operator, or for said examination, relative to the actual taking of a picture of a body part of a patient, (col. 6, lines 38-40; col. 11, lines 30-33)

- means in said one or more computers for analyzing calculating the data from said first computer, (col. 6, line 67-col. 7, line 24—e.g. generate cpt codes)
- means for producing a computer output from said one or more computers disclosing the results of any analysis performed on said data. (col. 7, lines 11-24-e.g. view codes)

[claim 8] Dorne discloses the apparatus as defined in claim 7, comprising means for determining whether any part of the monetary price, involved in the preparation of or the actual taking of the picture, should be, or should not be, added to the cost of the examination. (col. 9, lines 13-36, lines 53-60—determines if images should be approved and processed for billing reports to be generated)

[claims 11-12] Dorne discloses an apparatus further comprising means for determining how many of a particular examination have been performed and means for determining how much money a particular number of examinations produce. (col. 15, lines 60-col. 16, line 19)

[claim 13] Dorne discloses apparatus for monitoring the operations of a machine that takes pictures of the internal anatomy of a body, said machine comprising:

- one or more computers each having at least one memory, (Figure 1, ref. no. 100)

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- one or more of said computers having a program to perform the following operations:
 - o in said memory storing a standard procedure for said machine, or for said operator, or for said examination, applicable to take a picture for at least one medical reason, (col. 6, lines 9-17, Fig. 3C)
 - o said memory of said one or more computers having a program to perform the procedure for said machine, or for said operator, or for said examination relative to the actual taking of a picture of a body part of a patient, (col. 6, lines 38-40; col. 11, lines 30-33)
 - o a program in said one or more computers for analyzing and/or calculating the data, (col. 6, line 67-col. 7, line 24—e.g. generate cpt codes)
 - o said one or more computers having a program that enables it to produce the results of any analysis and/or computation performed on said data. (col. 7, lines 11-24-e.g. view codes)

[claim 14] Dorne discloses the apparatus as defined in claim 13, comprising means for determining whether any part of the monetary price, involved in the preparation of or the actual taking of the picture, should be, or should not be, added to the cost of the examination. (col. 9, lines 13-36, lines 53-60—determines if images should be approved and processed for billing reports to be generated)

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[claims 17-18] Dorne discloses an apparatus further comprising means for determining how many of a particular examination have been performed and means for determining how much money a particular number of examinations produce. (col. 15, lines 60-col. 16, line 19)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-4, 9-10, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorne (USPN 6,282,513).

[claims 3-4] Dorne discloses a method as defined in claim 1 as explained in the rejection of claim 1. Dorne further discloses a method in which the examinations may be reviewed prior to billing (col. 9, lines 3-36), but does not expressly disclose that the method comprises determining whether operator error occurred during the exam or taking of the picture and determining whether these errors contributed to the monetary costs of the exam or the preparation of the exam/picture taking. However, it is respectfully submitted that at the time of the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Dorne to determine whether an operator

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error, which contributed to the monetary cost of the exam/picture taking has occurred. One would have been motivated to include this feature to ensure physicians are appropriately compensated (col. 2, lines 18-28), while also ensuring that patients and insurance companies are not overcharged for services that were improperly or needlessly performed.

[claims 9-10] The limitations of claims 9-10 are addressed by the rejections of claims 3-4, and claim 7, and incorporated herein.

[claims 15-16] The limitations of claims 15-16 are addressed by the rejections of claims 3-4, and claim 13, and incorporated herein.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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11. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-4,7,10,14, and 16-18 of U.S. Patent No. 6,282,513.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter which the applicant claims in the instant application is broader than that sought in the parent application. In other word, claims 1,3-4,7,10,14, and 16-18 of U.S. Patent No. 6,282,513 fall entirely within the scope of claims 1-18 of the present application. The independent claims of the '513 patent recite additional limitations not recited or not required (i.e. recited in the alternative) in claims 1-18 of the instant application. However, the elimination of an element or its functions has been held to be an obvious modification. *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- Little et al (USPN 5,359,509) teaches a system and method for review of medical claims to prevent fraudulent activities.

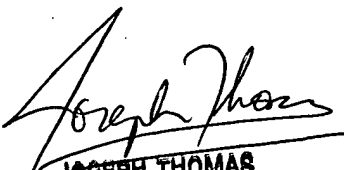
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP
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